


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 940472-267909	
ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE on <u>July 27, 2009</u> Signature <u>W. Kevin Ransom</u> Typed or printed <u>W. Kevin Ransom</u> name _____		Application Number 10/796,485 First Named Inventor Steven M. Stone Art Unit 3687	Filed March 9, 2004 Examiner Andrew J. Rudy
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>45,031</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">  _____ Signature W. Kevin Ransom _____ Typed or printed name (704) 331-3549 _____ Telephone number July 27, 2009 _____ Date </div>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/796,485 Confirmation No.: 2291
Applicant(s): Stone, et al.
Filed: March 9, 2004
Art Unit: 3687
Examiner: Rudy, Andrew J.
Title: SYSTEMS, METHODS AND COMPUTER PROGRAM PRODUCTS FOR
IMPLEMENTING PROCESSES RELATING TO RETAIL SALES

Docket No.: 940472-267909
Customer No.: 24239

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully submit that the Examiner has made a technical legal error in examining the application, and that such error has resulted in an improper rejection of the claims. Absent such technical legal error, the claims would be considered patentable in light of the references cited, but instead stand finally rejected.

In particular, the Examiner failed to adhere to express guidance in the Manual of Patent Examining Procedure (MPEP) on claim interpretation. This, in turn, led the Examiner to issue a legally and factually unsupported obviousness rejection. No *prima facie* case of obviousness has been established under 35 U.S.C. § 103. Applicants therefore request either reconsideration of the pending obviousness rejection and allowance of the claims, or at a minimum that the final rejection be lifted and the case be returned for examination with instructions to give the claim language proper weight.¹

¹ Applicants wish to inform the Examiners that Applicants have filed under separate cover a Petition to Withdrawal Finality of the Rejection. The Examiner's basis for finality is based on Applicant's alleged amendments to the claims. However, Applicants merely rewrote original dependent claim 6 into independent form incorporating verbatim the recitations of independent claim 1. No new claim language was added. In light of placing claim 6 in independent form and Applicants' remarks, the Examiner introduced a new prior art rejection, which does not constitute a grounds for designating a rejection as final under MPEP 706.07(a). As a designation of a rejection as final is not appealable, Applicants have submitted the separate Petition.

I. Summary of Claim Rejections

In the Final Office Action dated January 26, 2009, the Examiner alleges that the claims include intended use language and refused to give weight to such language in interpreting the claims. Further, the Examiner rejected pending Claims 2-6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,099,734 to Pieper ("PIEPER").

II. The Examiner Failed to Follow the Procedures Outlined in the MPEP in Interpreting the Claims Thereby Creating a Technical Legal Error

In the current Office Action, the Examiner alleges that recitations beginning with the phrase "is capable of" in the claims are intended use and thus should not be given weight. Applicants respectfully disagree. The Examiner's stance relative to this language is in error and contrary to MPEP guidelines. For example, MPEP § 2173.05(g) specifically states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself render a claim improper. ...

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step or a process to define a particular capability or purpose that is served by the recited element, ingredient or step. ...

....

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. (emphasis added) (citing *In re Barr*, 444 F.2d 588 (C.C.P.A. 1971)).

In a similar way, the claims of the present application use language such as "is capable of" to define various functional limitations of the processing element. Each of these recitations must be given weight in examination of the claims as the recitations act as functional limitations of the claims and define a particular capability or purpose that is served by the processing element. The

Examiner's refusal to give weight to these recitations is in violation of the express guidelines set forth in MPEP § 2173.05(g) and thus amounts to a technical legal error.

Furthermore, the Examiner's suggestion for amending the claims to overcome the rejection is not grounded in law, let alone any requirements of patentability. Specifically, instead of providing weight to the language of the claims as written, in the Advisory Action, the Examiner suggests that the alleged intended use language of the claims be positively recited to advance prosecution. That suggestion, however, may be considered contrary to MPEP guidelines, and Federal Circuit case law, which states that a single claim which claims both an apparatus and the method steps of using the apparatus would be improper. See MPEP 2173.05(p), Part II (citing *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384 (Fed. Cir. 2005)). Therefore, not only is the Examiner's failure to properly interpret the claims in error, his suggestion for revisions to the claims may also be considered an error if followed by Applicants.

III. The Examiner's Technical Legal Error Creates an Obviousness Rejection That is Legally and Factually Unsupported and Incapable of Establishing a *Prima Facie* Case of Obviousness under 35 U.S.C. § 103

As mentioned above, the Office Action rejects the claims as obvious over U.S. Patent No. 7,099,734 under 35 U.S.C. § 103(a). The '734 patent discloses a Computer Aided Design (CAD) method for product evaluation comprising a processing element and a graphical representation. The system disclosed in the '734 patent allows a garment designer to perform virtual tests on clothes designs to determine such aspects as wear and tear, fit, etc. The Office Action argues that the '734 patent's method to design and evaluate a product is equivalent to a system for facilitating the selection of a purchasable item. Applicants disagree with these rejections.

Applicants first note that the '734 patent is nonanalogous art. Section I of MPEP § 2141.01(a) states that "to rely on a reference under 35 U.S.C. 103, it must be analogous prior art." The '734 patent discloses a computer generated modeling of a single product in an environment for testing purposes. The present invention, however, relates to presenting products in an environment relating to retail sales. There is no disclosure in the '734 patent regarding display of purchasable items to a customer. There is no disclosure regarding allowing a user to select and view purchasable items. The '734 patent is directed to a specific function – providing a visual interface to a clothes

designer to allow the designer to test a clothing design and materials intended for use with the clothing. It is not clear, and indeed, not logical that one skilled in the art seeking to provide a system that allows customers to select and view purchasable items would know to look to a reference disclosing a system related to testing of clothes design. As a result, Applicants respectfully submit that the '734 patent is nonanalogous art and is improperly used in rejecting the claims of the current application.

Applicants further submit that the '734 patent neither anticipates nor renders obvious the claimed invention. Independent claim 6 of the present application claims "a processing element capable of proposing a plurality of purchasable items to the customer for selection by the customer." The processing element is also capable of

[P]roposing a second set of purchasable items to the customer for selection by the customer, and wherein said processing element is further capable of filtering the first set of purchasable items based at least in part upon the at least one customer preference to generate the second set of purchasable items.

At least this aspect of the claimed invention is nowhere taught by the '734 patent. The only plausible place that the '734 patent mentions generation of a list of items is the discussion beginning at Col. 18, line 17, where the '734 patent discloses the process of redesigning product sub-models for testing. Here, the '734 patent describes adding to or adjusting the original product's features for further testing during the evaluation process but does not, at any point, teach or suggest either filtering the first set of items or the generation of a second set of items based on customer preference. It merely discloses modifying at least one sub-model characteristic of the originally tested product for further evaluation. The '734 patent does not teach the option to select specific sub-model modifications at any point. Further, the '734 patent does not even suggest generating a list of options based on user preference. The claimed invention clearly is not anticipated by the '734 patent.

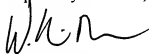
Further, Applicants respectfully submit that the '734 patent does not suggest or make it obvious to try the above recitation of independent claim 6. The '734 patent would not lead one of ordinary skill in the art to the claimed invention because the '734 patent neither explicitly describes nor implicitly suggests the claimed generation of item sets. When confronted with the issue of product set generation in a virtual retail environment, one of skill in the art would not look, or even think to look, to clothes modeling and testing for guidance. The present invention specifically claims a retail environment where first and second sets of purchasable items are generated based on customer preference. The '734 patent does not teach such a system or anything comparable. The

'734 patent does not describe the generation of sets of purchasable items, or filtering a first set of purchasable items to create a second set of purchasable items based on either a selection by a customer or a customer preference. It nowhere suggests such a problem of providing a filtered list of items to a customer or a solution to such problem. As such, in light of the above, Applicants respectfully submit that independent claim 6, as well as the claims that depend therefrom, are patentable over the cited reference.

IV. Conclusion

In light of the above, Applicants respectfully submit that the Examiner has made a technical legal error in interpreting the claims, which has resulted in a failure to establish a *prima facie* case of obviousness against the claims. Contrary to the Examiner's rejections, Applicants respectfully submit that all of the pending claims of the application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued, or at a minimum that the final rejection be lifted and the case be returned for examination with instructions to give the claim language proper weight.

Respectfully submitted,



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